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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/781,679	02/12/2001	Charles E. Hunter	WT-15	6129

35856 7590 10/07/2004

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EXAMINER

RAMAN, USHA

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 10/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/781,679

Applicant(s)

HUNTER ET AL.

Examiner

Usha Raman

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>08-19-2004</u> | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-17, 21-38, and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al. (US Pre Grant Pub. 20040054630).

In regards to claims 1, 2, 21, and 31, Ginter discloses a system and a method of distributing protected content to end users in a virtual distribution environment. In the system, a content owner, who control the distribution rights to movies, deliver digital movie disks to a plurality of distribution agents (publishers). Note paragraph 66 in page 5, paragraph 125 in page 8, paragraph 372 in page 30, and paragraphs 378, 379 in page 31. The publishers produce copies of the movie disks, and add additional information identifying them and their terms and conditions (in compliance with the content owner's terms and conditions) for subsequent distribution and usage of the movies. Note paragraph 380 in page 31. The publishers distribute the copies of the disk to end users, who have playback devices compatible with the disks, thus allowing them to view the desired movies. Upon playback of a movie at the end user site, information is communicated from the user site to a clearinghouse (system operator) that identifies the content

being played, along with the information (in header 800) identifying the content owner, and responsible distributing parties. Note page 73, paragraph 989. The clearinghouse receives a payment from the user each time the movie is played and compensates the content owner and responsible distribution parties accordingly. Note paragraph 80 in page 5, paragraph 200 in page 19, paragraph 388 in page 31-32, paragraph 2067 in page 169 and paragraph 2072 in page 170.

In regards to claim 3, Ginter discloses the step of the publishers making copies of the recorded media received from the content owner. Note paragraph 257 in page 27 and paragraph 379 in page 21.

In regards to claims 4, 24, and 33, upon playback of a movie, information identifying distribution agents and the media content are transmitted to the clearinghouse for billing purposes. Note page 73, paragraph 989, page 169, paragraph 2067, and page 170, paragraph 2072.

In regards to claims 5 and 23, Ginter discloses that the information can be transmitted to the system operator at defined times. Note page 10, paragraph 146.

In regards to claim 6, Ginter discloses transmitting to the system operator information indicating each time one of the copies is played. Note page 31, paragraph 376.

In regards to claim 7, the clearinghouse charges consumers based on information received. Note paragraph 388 in page 31.

In regards to claim 8, Ginter discloses charging a user for each access of content. Note page 33, paragraph 403.

In regards to claim 9, Ginter discloses a flexible metering scheme where a user can be charged each time a content is played or a user can be charged a single fee for accessing a content unlimited times during a certain time duration. The user is thus charged a variable fee (a one time fee) for accesses during that time duration and a pay per play fee for accessing outside that time duration. Note paragraph 1083 in page 83.

In regards to claims 10 and 25, Ginter discloses distributors can be retailers and one of the metering schemes is "rental" of videos, therefore the system has the means for user to go to the retail store to obtain a copy and use the rental video payment scheme and return the video upon viewing. Note paragraph 178 in page 14 and paragraph 1004, page 74.

In regards to claims 12, 22, 26, 32, 34, and 35, the clearinghouse receives a payment from the user each time the movie is played and compensates the content owner and responsible distribution parties accordingly. Note paragraph 80 in page 5, paragraph 200 in page 19, paragraph 388 in page 31-32, paragraph 2067 in page 169 and paragraph 2072 in page 170.

In regards to claim 13, Ginter discloses the step of charging distribution agents for the recordings delivered to the distribution agents. Note page 31, paragraph 378.

In regards to claims 14, 27, and 36, Ginter discloses that contents are VDE protected such that devices that cannot detect the VDE protected content cannot read the data. Ginter provides identified VDE electronic appliances running a rights operating system for reading VDE content in accordance with the system. Note paragraphs 458 and 459 in page 36.

In regards to claim 15, media content have "rules and controls" security code embedded by the content owners and the media players only output data having the rules and terms security code specified. Note paragraph 414 in page 33 of Ginter.

In regards to claims 16, Ginter discloses that the tangible medium is digital movie disk. Note paragraph 147, page 10.

In regards to claims 17, 28, and 37, Ginter discloses that the tangible medium is an optical disk. Note paragraph 381, page 31.

In regards to claim 29, Ginter discloses that the content is electronic digital information. Note page 1, paragraph 7

In regards to claims 30, and 40, see claims 14 and 15.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (US Pre Grant Pub. 2004/0054630) in view of Yuen et al. (US Pat. 6,147,715).

In regards to claim 18, Ginter does not teach the step of providing user with guides identifying the copies possessed by consumer.

Yuen discloses providing a tape index guide for identifying movies that are recorded in a storage medium such as a video cassette.

It would have been obvious to one of ordinary skill in the art to modify the system of Ginter by providing a "tape index guide" to identify the movies in the storage medium (digital movie disk), as taught by Yuen. The motivation is to provide a user with on screen navigation directory, for guiding user with movie selections.

5. Claims 19, 20, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ginter et al. (US Pre Grant Pub. 2004/0054630) in view of Yuen et al. (US Pat. 6,147,715) as applied to claim 18 above, and further in view of Lowthert (US Pre Grant Pub. 2002/0100043).

In regards to claims 19, 20, and 39, the modified system of Ginter in view of Yuen does not have means to update information in the guides.

Lowthert discloses of providing links for various contents such as, advertisements, EPG, program content, etc. and periodically updating an info segment that contains the updated information to be associated with the program content. Such a system overcomes the drawback of "stale" or old advertisements

that are recorded in a digital movie disk. Note page 1, paragraph 5, abstract and paragraph 49 in page 4.

It would have been obvious to one of ordinary skill in the art to further modify the system of Ginter in view of Yuen with teachings of Lowthert by associating the movies in available in the digital movie disk with content names and storing that information in the tape index guide, and updating the info segment associated with the EPG. The motivation is to identify the most up to date advertisements to be associated with the movie content in the EPG. Furthermore, the modified system also allows for targeted advertisements.

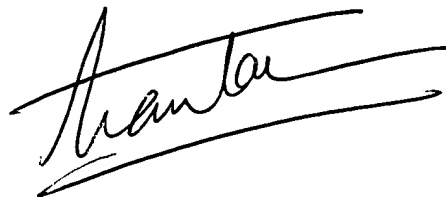
Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (703) 305-0376. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

UR
10-01-04

A handwritten signature in black ink, appearing to read "HAITRAN", written over two horizontal lines.

HAITRAN
PATENT EXAMINER